

REMARKS

Applicants request favorable reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks.

Claims 1, 2, 6-8, 17, 19, 22-24, 26, 28, and 46-49 are now pending, with Claims 1, 17, 26, 48, and 49 being independent. Claims 2, 4, 5, 9, 11, 13, 18, 20, 21, and 25 have been cancelled without prejudice or disclaimer of subject matter. Claims 1, 3, 6-8, 17, 19, 20, 22-24, 26, and 28 have been amended. Claims 46-49 are new. Support for the amendments and new claims can be found throughout the originally-filed disclosure, including, for example, in Figure 2. Thus, Applicants submit the amendments and new claim include no new matter.

Claims 1-9, 11, 13, 17-26, and 28 were rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Nehab et al. (U.S. Patent No. 6,029,182) in view of Vidyanand (U.S. Patent App. Pub. No. 2006/0023246).

Applicants respectfully traverse the rejection. Nevertheless, without conceding the propriety of the rejection and solely to expedite prosecution, Applicants have amended independent Claims 1, 17, and 26 so as to clarify features of the invention not disclosed or suggested by the cited references. To this end, Applicants submit that amended claims 1, 17, and 26 are patentably distinguishable from the cited references, for at least the following reasons.

The Office Action asserts that Nehab et al. discloses an image forming apparatus comprising, *inter alia*, “an external apparatus,” as recited in claims 1, 17, and 26 of the present application. More specifically, the Office Action equates Nehab et al.’s disk 5 to the claimed external apparatus, and asserts that the disk 5 includes all of the features of claimed external apparatus.

Applicants respectfully submit, however, that the disk 5 of Nehab et al. cannot properly be equated to the “external apparatus” recited in claims 1, 17, and 26 for many reasons.

Initially, Applicants submit that the disk 5 of Nehab et al. does not receive acquisition information and layout information, nor does disk 5 generate printing data as recited in the claims of the present application.

The Office Action appears to argue that as the disk 5 includes various personal news retrieval files 15, such as Web Printer 17 and Formatter 18, the disk 5 functions to acquire information and generate data for output using the personal retrieval files 15. In order to equate the disk 5 to the “external apparatus” recited in claims 1, 17, and 26, the Office Action’s position necessitates that the personal news retrieval files on the disk 5, receive data, such as a URL address of a document to be formatted, and the personal news retrieval files on the disk 5, generate data based on the received information.

Applicants respectfully submit this characterization of disk 5 acquiring and generating data is incorrect. Under nearly every, if not all, computer and disk type operating systems, such as the system disclosed by Nehab et al., programs stored on a disk are not executed on the disk. Instead, the disk merely functions to load the programs onto memory of the computer, and the computer’s CPU executes the programs. To this end, Nehab et al. explicitly discloses:

Main memory 14 interfaces with computer bus 9 so as to provide random access memory storage for use by CPU 8 when executing an application such as personal-news-profile editor 16 or Web printer 17. More specifically, CPU 8 loads these software applications from disk drive 5 into main memory 14 and executes the software applications out of main memory 14. In accordance with user instructions, stored application programs are activated which permit processing and manipulation of data.

Col. 5, lines 59-65 (emphasis added). Nehab et al., therefore, expressly discloses the personal news retrieval files 15 of disk 5 are executed in computer, using the computer's RAM and CPU. The personal news retrieval files 15 are not executed on the disk 5. Applicants at no point does Nehab et al. state that data is sent to the disk to be processed on the disk with the personal news retrieval files 15. Indeed, processing on the disk would be contrary to the express teachings of the reference that the personal news retrieval files 15 of disk 5 are executed in in the computer, not on the disk.

With the disk and computer configuration of Nehab et al. in mind, Applicants submit that the disk 5 cannot be properly equated to the "external apparatus" recited in Claims 1, 17, and 26. For example, the disk 5 does not acquire data in accordance with sent acquisition information and/or layout information. Nor does disk 5 generate printing data. Again, the personal news retrieval files 15 of Nehab et al. which are merely stored on disk 5. The personal news retrieval news files 15 only process data when loaded onto the computer.

Applicants further submit Nehab et al. does not teach or suggest an external apparatus which is connected to a printer via network, as recited in Claims 1, 17, and 26. As noted above, the Office Action equates Nehab et al.'s disk 5 to the external apparatus claimed in the present application. The disk 5 of Nehab et al., however, is not connected to the computer via a network. Instead, the disk is connected using disk drive 5. Claims 1, 17, and 26 of the present application, on the other hand, recite that a printer is connected to an external apparatus via a network. The claims further recite that acquisition information and/or layout information is sent to the external apparatus via the network. The disk 5 of Nehab et al. does not receive acquisition information or layout information via a network, nor does Nehab et al. include any other element that can be

equated to an external apparatus connected to a network, with the external apparatus having the combination of features as recited in Claims 1, 17, and 26.

Applicants still further submit that the Office Action's characterization of the disk 5 of Nehab et al. as being an "external" apparatus not a reasonably broad interpretation of the term as it is used in the present application. The Office Action argues that the disk 5 is "external" since it is removable from the apparatus. The disk 5 of Nehab et al., however, does not function when removed from Nehab et al.'s computer. Claims 1, 17, and 26 of the present application, however, clearly require the printer to communicate data with the external apparatus, with the external apparatus not being part of the printer structure. Note, for example, the discussion above of the external apparatus being connected by a network to the printer.

With respect to new independent Claims 48 and 49, Applicants submit Nehab et al. fails to teach or suggest the printer and control method as recited in these claims, for analogous reasons to those noted above with respect to Claims 1, 17, and 26. For example, Claims 48 and 49 recite, inter alia, a web server holding a plurality of web pages the receives, via a network, a URL and layout information from the printer. Plainly, the disk 5 of Nehab et al. cannot be understood to equate to such a web server. Nor, in Applicants' view, does anything else in the disclosure of Nehab et al. disclose or suggest these features.

Applicants further submit the secondary citation to Vidanand does not cure the above-noted deficiencies of Nehab et al. Vidanand is cited in the Office Action as allegedly disclosing to include information on a recording medium in layout information. Vidanand, however, does not disclose or suggest an external apparatus, or a web server, in combination with the other features recited the independent claims of the present application.

For at least the foregoing reasons, Applicants submit that Nehab et al. and Vidanand, whether taken individually or collectively, fail to teach or suggest the apparatuses and methods recited in the independent claims of the present application.

Applicants further submit the dependent claims should also be deemed allowable in their own right for defining other patentable features of the present invention in addition to those recited in the independent claims. Further individual consideration of the dependent claims is requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration, withdrawal of the outstanding rejection, and passage to issue of the present application.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

/Donald H. Heckenberg, Jr./

Donald H. Heckenberg, Jr.
Attorney for Applicants
Registration No. 60,081

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

FCHS_WS 2121917_I.DOC